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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,246	07/18/2003	Milind Rajopadhye	BMS-2288(DM-6958-A)	3130
23914	7590	08/11/2004	EXAMINER	
STEPHEN B. DAVIS BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			JONES, DAMERON LEVEST	
			ART UNIT	PAPER NUMBER
			1616	
DATE MAILED: 08/11/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,246

Applicant(s)

RAJOPADHYE ET AL.

Examiner

D. L. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-58 and 66-83 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 52-58 and 66-83 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

RESTRICTION INTO GROUPS

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 52-57, 66, 67, and 70-83, drawn to a composition, kit, and method of treating cancer comprising $\alpha 5\beta 1$ receptor, a peptide/peptidomimetic, a chelator, optionally, a linker, a *chemotherapeutic agent*, and optionally, a metal, classified in class 424, subclass 1.69.
 - II. Claims 52, 53, 58, 66, 68, and 70-83, drawn to a composition, kit, and method of treating cancer comprising $\alpha 5\beta 1$ receptor, a peptide/peptidomimetic, a chelator, optionally, a linker, a *radiosensitizer agent*, and optionally, a metal, classified in class 424, subclass 1.69.
 - III. Claim 69, drawn to a process of preparing a *diagnostic* metallopharmaceutical composition comprising a plurality of molecular components which includes a targeting moiety and a chelator, classified in class 424, subclass 1.11.
 - IV. Claim 69, drawn to a process of preparing a *therapeutic* metallopharmaceutical composition comprising a plurality of molecular components which includes a targeting moiety and a chelator, classified in class 514, subclass 1.

Note: Claims appearing in more than one group will be examined only to the extent that they read upon the elected invention.

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2. Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions require different components (i.e., Groups I and II, one group requires a chemotherapeutic agent and the other a radiosensitizer agent) which are not obvious over one another. In addition, different metallopharmaceuticals are generated for different purposes (i.e., Groups III and IV), one group requires a diagnostic metal and the other a therapeutic metal.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

ELECTION OF SPECIES

5. Claims 52-58 and 66-83 are generic to a plurality of disclosed patentably distinct species comprising various compositions, kits, and methods of treating cancer. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species *for search purposes*, even though this requirement is traversed.

Note: *The Examiner respectfully requests that the Applicant elect a single disclosed species for search purposes from within the elected group above. The elected species should include the peptide/peptidomimetic, the chelator, the linker, the radiosensitizer, the chemotherapeutic agent, the metal, and the cancer. In addition,*

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Applicant is requested to identify all variables associated with the elected species and state which claims are directed to that species.

6. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Due to the complexity of the restriction requirement, a telephone call to request an oral election to the above restriction requirement was not made.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617.

The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


D. L. Jones
Primary Examiner
Art Unit 1616

August 4, 2004